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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellants: Brockley et al.

Serial No.: 09/783,366 Group Art Unit: 3611

Filed: February 14, 2001 Examiner: Davis, Cassandra

Title: SPORTS COMMEMORATOR FOR DISPLAYING A SPORTS RELATED OBJECT AND PICTURE

CERTIFICATE OF MAILING

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APPELLANTS' REPLY BRIEF TO THE BOARD OF  
PATENT APPEALS AND INTERFERENCES

Dear Sir:

In reply to the Examiner's Answer dated July 16, 2004, appellants submit this Reply Brief under new rules, 37 C.F.R. Part 41. The Reply Brief is due by September 16, 2004 without extension. Therefore, this Reply Brief is being timely filed.

ARGUMENT

Initially, appellants gratefully acknowledge the Examiner's withdrawal of the rejection to the claims of Group 1, Subgroup (i), i.e., claims 1, 1, 5-9, 13, 17, 21-24, 28 and 32, as noted on page 6, section (11) of the Examiner' Answer in light of appellant's Appeal Brief.

Appellants also point out that at the time of the Examiner's Answer and under the old rules, it is not proper to issue new grounds of rejection.

In any event, appellants respectfully, but most strenuously, disagree with the Examiner's new grounds of rejection of the claims of Group 1, Subgroup (i), which relies on the same prior art references as the earlier rejection, namely, Wilson et al. (U.S. Patent No. 5,813,546), Feher (U.S. Patent No. 861,822), and Rand (U.S. Patent No. 405,678).

Issue No. 1

Appellants disagree with the characterization of Wilson et al. on pages 3 and 4 in the Examiner's Answer. In particular, the second full paragraph on page 4 reads as follows:

As an optional feature, Wilson teaches a secondary display section 63 formed by removing some of the backing material 59 below the hollow portion 15. (See figure 3). This secondary display section 63 can be sized and shaped to accommodate a single ticket (not shown), or a number of tickets in a fan layout. *This permits the cap's collector to simultaneously display tickets to an event associated with the cap (not shown), wherein the ticket can correspond to*

*the picture on a layer.* (See column 3, lines 41-47). (italics in the original)

However, there is no disclosure or teaching in Wilson et al. for the statement that "*wherein the ticket can correspond to the picture on a layer.*" Specifically, Wilson et al. in column 3, lines 41-47, fail to describe or support such a position. More specifically, Wilson et al. describe the secondary display section 63 sized and shaped to accommodate a single ticket or a number of tickets in a fan layout. Wilson et al. also describe that a second hollow form may be provided below the hollow form for the cap. The second hollow form could be adapted for displaying a golf ball, a baseball, or other small memento associated with the cap being displayed. See Wilson et al. at column 3, lines 41-56.

Accordingly, there is no disclosure or teaching in Wilson et al. for the ticket corresponding to a picture on a layer.

Issue No. 2

Appellants also disagree with the Examiner's newly argued positions in response to appellants' arguments. Specifically, appellants disagree with the Examiners position regarding the cap display in Wilson et al., and in particular, that "[t]he Examiner considers the ticket and indicia thereon can correspond to a picture having indicia associated with the sports object, namely, the cap." See, Examiners Answer at page 7, lines 17 and 18.

As noted above with regard to Issue 1, there is no disclosure or teaching in Wilson et al. that the ticket corresponds to a picture. Neither is there any disclosure or teaching in Wilson et al. nor is any support provided by the Examiner for the Examiner's position in Wilson et al. that the ticket corresponds to a picture associated with the cap.

Issue No. 3

Appellants further disagree with the characterization that appellants' invention as recited in the claims allegedly lacks patentability in light of Wilson et al. and Rand.

The Examiner correctly notes that Wilson et al. does not teach a) the display surface of the backing material having a picture thereon, and b) forward and rearward interfaces. See, Examiner's Answer at page 4, lines 14 and 15.

In addition, Wilson et al. also do not disclose, teach or suggest c) "said picture illustrating a scene relating to said sports related object", d) "displaying said picture behind said object", e) the sports related object being "visually associated with" the scene, and wherein, f) the sports related object "does not substantially obscure said scene", as recited in independent claims 1, 17, and 32.

It is the Examiner's position in the Examiner's Answer (page 7, line 18 to page 8, line 6) that Rand allegedly teaches:

1) a display comprising a picture frame, a bird, and a back having a front surface which may be "painted, colored, or arranged with any design or picture for a pleasing background";

2) the bird is an object used by the participant in the sport of hunting by providing an object or target in which the hunter aims;

3) the picture depicted shows a nature scene corresponding to the environment in which the bird inhabits; and

4) the bird is placed in front of the backing with the picture, the bird is placed in such a way as to blend into the scene depicted in the background picture,

and it is also the Examiner's position that "that device taught by Wilson et al. can be modified to include a picture on the backing relating to the hat as taught by Rand. See, Examiners Answer at page 8, lines 7-9.

First, appellants respectfully disagree that the bird is "an object used by the participant in the sport of hunting." In particular, the cabinet for preserving and displaying game in Rand includes a bird that is not an object usable by the hunter, but instead, an animal under pursuit. In the context of hunting, a gun or a rifle for example, would be an object usable by a hunter in aiming at the bird under pursuit in hunting, and not the bird.

Thus, the combination of Wilson et al. and Rand fail to disclose, teach or suggest a display having the features of a "sports related object usable by a participant in engaging in a sport" and "a picture illustrating a scene relating to said sports related object" as recited in independent claims 1, 17, and 32.

Second, appellants respectfully disagree with the position taken in the Examiner's Answer in the second full paragraph on page 4 that:

It would have been obvious to one having ordinary skill in the art at the time this invention was made to construct the display surface of the backing material of the cap display apparatus taught by the Wilson with a picture on

the backing material that corresponds with the three-dimensional object as taught by Rand to enhance the appearance of the display.

In particular, the proposed combination cannot change the principle of operation of the primary reference or render the reference inoperable for its intended purpose. Specifically, Wilson et al. is directed to a "CAP DISPLAY" as the title, specification, and claims all explicitly state. The cap is best viewed at about eye level with a desirable location for display on a wall, at about eye level, with the cap canted so that both the bill and the front of the crown can be viewed simultaneously with equal prominence. See, Wilson et al. at column 1, lines 29-33.

As such, the cap display apparatus of Wilson et al. requires that the hollow form 15 for receiving the cap has a crown section 17 and a bill section 19, the cap be positioned in front of and occupy substantially all of the frame, the cap being canted downwardly to display the indicia on the front to the cap.

In this case, the attempted proposed combination of Wilson et al. and Rand changes the principle of operation of the display disclosed in Wilson et al. for showing off the cap, and in particular showing off the logos, insignia, emblems, symbols, designs, etc. which are typically embroidered on the front of the cap. More particularly, Wilson et al. specifically disclose that a "piece of backing material 33 provides a contrasting background for the cap 21." See, Wilson et al. at column 2, lines 60-61. *Merriam Webster's Collegiate Dictionary*, Tenth Edition, 1993, defines "contrast" as "juxtaposition of dissimilar elements (as color, tone, or emotion) in a work of art." Attempting to incorporate a picture (if possible) into the cap display apparatus of Wilson et al. would result in the logos, insignia, emblems, symbols, designs, etc. embroidered on the front of the cap being less visible to an observer. Thus, attempting to

incorporate a picture into the cap display apparatus of Wilson et al. (to enhance the appearance of the cap display as suggested in the Examiner's Answer) improperly changes the basic principal under which the display in Wilson et al. is constructed for showing off the cap with a contrasting background

Furthermore, it is not clear how a picture would be incorporated in the cap display apparatus device of Wilson et al. since the cap itself occupies almost the entire display, let alone the cap being visually associated with and not substantially obscuring the picture. In addition to the hat obscuring a picture, Wilson et al. also describes cutting out a portion of the display or backing material, e.g., secondary display section, and therefore, cutting out a portion of the picture if it is even possible to incorporate a picture in the cap display apparatus of Wilson et al.

Based on the foregoing, appellants respectfully request reversal of this new obviousness rejection of independent claims 1, 17, and 32, as well as the claims depending therefrom.

Issue No. 4

Appellants respectfully disagree with the position taken in the Examiner's Answer in the third full paragraph on page 4 that:

In addition, it would have been obvious to one having ordinary skill in the art at the time this invention was made to mount the display taught by Wilson and Rand within the frame taught by Feher as an alternate frame means whereby the display can be selectively inserted and removed from the rear of the frame.

With reference to Feher, Feher discloses an embossed picture showing a scene of a historical or biblical nature. The embossed picture includes a frame for supporting an embossed piece of celluloid that can be suitably colored, painted or printed to produce a life-like effect of a person in the picture. The embossed picture also includes an outer celluloid sheet.

More importantly, Feher fails to disclose, teach or suggest, the features lacking in Wilson et al. and Rand, as noted above, for supporting a rejection of claims 1, 17, and 32.

Based on the foregoing, appellants respectfully request reversal of this new obviousness rejection of independent claims 1, 17, and 32, as well as the claims depending therefrom.

Issue No. 5

With regard to claims 32 and 43-45 (it appears that the Examiner was referring to claims 37, 40, and 43), appellants disagree with the position taken in the Examiner's Answer that incorporating a scene comprising an image of a person associated with the sports related object would perform equally well in enhancing the aesthetic appearance of the cap display apparatus.

First, the Examiner's Answer correctly notes that the prior art of record does not specifically show a picture of a person associated with the sports related object.

Second, as noted above, attempting to incorporate a picture into the cap display apparatus of Wilson et al. (to enhance the appearance of the cap display as suggested

in the Examiner's Answer) improperly changes the basic principal under which the display in Wilson et al. is constructed for showing off the cap with a contrasting background.

Accordingly, the combination of Wilson et al. and Rand would fail to disclose, teach or suggest, "said scene comprises an image of a person associated with said sports related object" as recited in claims 37, 40, and 43.

Issue No. 6

With regard to claims 38, 41, and 44, the Examiner contends that the scene depicted in Rand shows a natural habitat of the bird on display and thereby shows the location in which the hunting would take place.

However, there is no indication that the scene in Rand is an "actual" location.

Accordingly, the combination of Wilson et al. and Rand would fail to disclose, teach or suggest, a sports commemorator in which "said scene comprises a scene illustrating an actual location associated with said sports related object" as recited in claims 38, 41, and 44.

Issue No. 7

With regard to claims 32 and 43-45 (it appears that the Examiner was referring to claims 39, 42, and 44), and wherein the scene illustrates an actual location commemorating an occasion where a sports related object is used, appellants disagree with the position taken in the Examiners' Answer that providing any suitable related

background scene as taught by Rand would perform equally well in enhancing the aesthetic appearance of the cap display apparatus in Wilson et al.

First, the prior art of record does not disclose, teach or suggest, a scene illustrating an actual location commemorating an occasion where a sports related object is used.

Second, as noted above, attempting to incorporate a picture into the cap display apparatus of Wilson et al. (to enhance the appearance of the cap display as suggested in the Examiner's Answer) improperly changes the basic principal under which the display in Wilson et al. is constructed for showing off the cap with a contrasting background.

Accordingly, the combination of Wilson et al., Rand, and Feher would fail to disclose, teach or suggest appellants' sports commemorator which may be provided at an event and where "said scene comprises a scene illustrating an actual location commemorating an occasion where the sports related object was used" as recited in claims 39, 42, and 45.

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CONCLUSION

Appellants respectfully submit that the new grounds of rejection should be reversed in all respects.



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